



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/914,628	08/19/97	SHEFFIELD	D 001.003.

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IM7170301

EXAMINER

DYE, R

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

03/01/9

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

08/914,628

Applicant(s)

Sheffield

Examiner

R. Dye

Group Art Unit

1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on 8/19/97, 10/2/97 and 1/28/99.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Status Inquiry***

1. In response to Applicant's status inquiry letter filed on January 28, 1999, the Preliminary amendment filed on October 2, 1997 has been entered in the file. The formal drawings filed with the Preliminary Amendment have been sent to the Drafting Division. The reference to application serial no. 08/944,070 stamped on Applicant's return postcard was apparently an error.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "the wall thickness of said ornament *can* be uniform," is indefinite because it does not clearly define any definite structure with respect to the thickness of the ornament.

In claim 1, the phrase "the surface area" has no antecedent bases.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 2, the term "irregular" is indefinite. What is the ornament "irregular" to or how is the ornament "irregular"?

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, the phrase "wherein the contoured walls...are tapered gradually from 1/8 inch thickness at the center of mass to 1/16 inch thickness at the periphery" is indefinite. How can the walls be tapered when, *assuming arguendo*, that "the wall thickness of the ornament can be uniform" as recited in claim 1? "Tapered" is understood by the Examiner to mean that the thickness of the ornament gradually decreases toward the edges.

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, the phrase "tapered walls form a uniform, conical shaped..." is indefinite. It is not clear in this phrase how the ornament can be uniform with tapered walls.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheffield et al. (5,714,215).

Sheffield et al. teaches a unitary, one-piece display ornament of a symmetrical shape comprising a flexible sheet of material, having contoured walls which form a convex exterior surface and a concave interior surface. The interior surface is capable of adhering to substrates by a vacuum force when compressed against a substrate. The wall thickness of the ornament is uniform in the entire area with the exception of the peripheral edges. As illustrated in figure 4 the walls form a conical shaped core containing the center of the mass of the ornament wherein the core occupies at least 40% of the total area of the ornament which would contain at least 50% of the overall mass of the ornament (figures 1-4; columns 3-4).

Sheffield et al. fails to specifically teach the surface area being from about 3 in<sup>2</sup> to about 25 in<sup>2</sup> (claim 1), an irregular or unsymmetrical shape (claim 2), and the wall thickness 50% less than at its center of mass (claim 2). It would have been obvious to the ordinary artisan to have varied the size of the display ornament depending on the size of that which is to be displayed, therefore, varying the size of the surface area of the ornament of the ornament or the

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surface area of the surface to which it is to be applied to. Varying the shape, such as that which is irregular or unsymmetrical, would have been obvious to the ordinary artisan to have made the display ornament more aesthetically pleasing. Although Sheffield fails to teach the periphery being at a wall thickness 50% less than at its center of mass, it would have been obvious to the ordinary artisan to have varied the thickness of the periphery to have increased the amount of flexibility and ease with which the ornament can be compressed to form a vacuum seal to the substrate.

8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plante (1,922,900).

Plante teaches a unitary, one-piece display ornament of a symmetrical shape comprising a flexible sheet of material, having contoured walls which form a convex exterior surface and a concave interior surface wherein the interior surface is capable of adhering to substrates by a vacuum force when compressed against a substrate (figure 2) and having a uniform thickness in the most center portion of the display ornament. As illustrated in figure 2 the walls form a conical shaped core containing the center of the mass of the ornament wherein the core occupies at least 40% of the total area of the ornament which would contain at least 50% of the overall mass of the ornament (column 1, lines 32-52).

Plante fails to specifically teach the surface area being from about 3 in<sup>2</sup> to about 25 in<sup>2</sup> (claim 1), an irregular or unsymmetrical shape (claim 2), and the wall thickness 50% less than at

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its center of mass (claim 2). It would have been obvious to the ordinary artisan to have varied the size of the display ornament depending on the size of that which is to be displayed, therefore, varying the size of the surface area of the ornament or the surface area of the surface to which it is to be applied to. Varying the shape, such as that which is irregular or unsymmetrical, would have been obvious to the ordinary artisan to have made the display ornament more aesthetically pleasing. Although Plante fails to teach the periphery being at a wall thickness 50% less than at its center of mass, it would have been obvious to the ordinary artisan to have varied the thickness of the periphery to have increased the amount of flexibility and ease with which the ornament can be compressed to form a vacuum seal to the substrate.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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10. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,714,215. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims as recited in the instant patent application recite that which would encompass the flexible information presentation board as claimed in US Patent 5,714,215. Furthermore, the recitation of "surface area being from about 3 square inches to about 25 square inches", as recited in claim 1 of the instant patent applicant, and best understood by the Examiner, would have been obvious to the ordinary artisan depending on the size of that which is to be displayed, therefore, varying the size of the surface area of the ornament or the surface area of the surface to which it is to be applied to.

11. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. . Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims as recited in the instant patent application recite that which would encompass the information presentation sheet board structure as recited in copending application serial no. 08/914,885. Furthermore, the recitation of "surface area being from about 3 square inches to about 25 square inches", as recited in claim 1 of the instant patent applicant, and best understood by the Examiner, would have been obvious to the ordinary artisan depending on the size of that

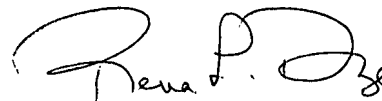


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which is to be displayed, therefore, varying the size of the surface area of the ornament of the ornament or the surface area of the surface to which it is to be applied to.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Dye whose telephone number is (703) 308-4331.



Rena L. Dye  
Primary Examiner  
Group 1700

R. Dye  
February 25, 1999